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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,188	07/21/2000	Jeffrey Delaney	109140-0004	3752

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EXAMINER

WANG, LIANG CHE A

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 07/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/621,188

Applicant(s)

DELANEY ET AL.

Examiner

Liang-che Alex Wang

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Primer Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-36 have been examined

#### ***Paper Submitted***

2. It is hereby acknowledged that the following papers have been received and placed of record in the file:
  - a. **Information Disclosure Statements** as received on 10/10/2000.
  - b. **Change of Address** as received on 06/17/02.

#### ***Priority***

3. The drawings in this application are objected to by the Draftsperson as informal. Any drawing corrections requested, but not made in the prior application should be repeated in this application if such changes are still desired. If the drawings were changed and approved during the prosecution of the prior application, a petition may be filed under 37 CFR 1.182 requesting the transfer of such drawings, provided the parent application has been abandoned. However, a copy of the drawings as originally filed must be included in the 37 CFR 1.60 application papers to indicate the original content.

#### ***Claim Objections***

4. Claims 1-12, 16-21, 23-36 are objected to because of the following informalities:

5. Referring to claims, 1, 4-7, 11-12, 16-19, 23-25, 28-31, 35-36, recites the limitation of **“the application”** which lacks of antecedent basis, which should be changed to **“the remote application”** to make the claim consistent and valid for examination.
6. All dependent claims are objected to as having the same deficiencies as the claims they depend from.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3-9, 12, 13, 15-21, 24, 25, 27-33, 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Pepe et al., US Patent Number 5,742,905, hereinafter Pepe.
9. Referring to claim 1, Pepe has taught a messaging system (see figure 3), comprising:
  - a. a message server (figure 3 and 5 item 48) comprising a plurality of modalities for transmitting messages (figure 3, item 30, 32, 34, Col 4 lines 37-41), the message server being responsive to a remote application (Col 3 lines 45-48) configured to generate a message and a destination of at least one of the transmission modalities (Figure 3 items 20-26, and Figure 5, and Col 6 lines 62-64), the message server communicating with the remote application via a computer network (Col 3 lines 48-52); and

- b. an application interface (API) comprising stored instructions executing on the message server (see item 48, in figure 5), the API receiving the message and destination from the remote application and causing the message server to effect transmission of the message according to the destination (Col 5 lines 54-67, Col 6 lines 1-10, and also Figures 28-45.)
- 10. Referring to claim 3, Pepe has further taught wherein the message server comprises a database for storing contact data (item 44, Figure 5), the API being configured to process a request from the application to establish a database record specifying a member and contact data for the member (member profile), the contact data including at least one contact method specifying a transmission modality, the API causing the message server to send the message in accordance with the contact data (Col 6 lines 60-Col 7 lines 15, and also see Figure 28-45.)
- 11. Referring to claim 4, Pepe has further taught wherein the message server comprises a database (item 44 figure 5) for storing contact data for a plurality of members (Col 6 lines 60-65), the API being configured to process a request from the remote application (Col 3 lines 45-48) to access an existing database record specifying a member and contact data for the member (from the member profile), the contact data including at least one contact method specifying a transmission modality and data facilitating contact of the member via specified transmission modality (Col 3 lines 48-54, Col 6 lines 1-10.)
- 12. Referring to claim 5, Pepe has further taught wherein the API is further configured to process a request from the remote application to create a distribution list comprising a plurality of the existing database records, the API causing the message server to send the

message to the members in the distribution list in accordance with the contact data (see Figure 44.)

13. Referring to claim 6, Pepe has further taught wherein the existing database record comprises a plurality of contact method (see Figure 33), the API being further configured to process a request from the remote application specifying at least one of the contact method (Col 6 lines 5-10), the API causing the message server to send the message to the member in accordance with the at least one specified contact method (Figure 33 and Col 6 lines 5-10.)
14. Referring to claim 7, Pepe has further taught wherein the API is further configured to respond to status requests from the application, the API returning, in response to a status request specifying a messaging task, status information pertinent to the messaging task (see Figure 31, and Col 34 lines 37-46.)
15. Referring to claim 8, Pepe has further taught wherein the status information includes a status designation for the message (Col 34 lines 38-46), the status designation specifying (i) whether the message has been sent (Col 34 lines 39, message is being answered), (ii) whether the message was successfully received (Col 34 line 39, answered, or lines 39-40, forwarded to voice mail), (iii) whether the message failed (Col 34 lines 41, unanswered) (iii) whether the message has been cancelled (Col 34 lines 41, hung up before answered.)
16. Referring to claim 9, Pepe has further taught wherein for each failed message, the API returns an explanation for the failure (Col 34 lines 41, unanswered is considered as an explanation for failure.)

17. Referring to claim 12, Pepe has further taught wherein the API is configured to handle information in the form of objects (Figure 28-45), the objects including:

- i. member objects designating member information for a plurality of potential recipients of the message (Col 6 lines 62-64);
- ii. contact objects specifying information facilitating communication with the potential recipients in accordance with a plurality of transmission modalities (Col 5 lines 59-62);
- iii. job objects specifying messages and characteristics thereof (See Figures 42 and 45) and
- iv. delivery objects specifying modes of message delivery (Figure 33 and Col 34 lines 51-56) the application providing the message and the designation in object form (Figures 44 and 45 and Col 36 lines 38-42.).

18. Referring to claims 13, 15-21, and 24, claims 13, 15-21, and 24 encompass the same scope of the invention as that of the claims 1, 3-9, and 12. Therefore, claims 13, 15-21, and 24 are rejected for the same reason as the claims 1, 3-9, and 12.

19. Referring to claims 25, 27-33, and 36, claims 25, 27-33, and 36 encompass the same scope of the invention as that of the claims 1, 3-9, and 12. Therefore, claims 25, 27-33, and 36 are rejected for the same reason as the claims 1, 3-9, and 12.

### ***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2155

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 2, 14, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe in views of Lewis, US Patent Number 6,513,019, hereinafter Lewis

22. Referring to claim 2, Pepe has taught an invention as described in claim 1, Pep has not taught wherein the API is configured to interpret XML syntax, the message and the designation being expressed as a request formatted in XML syntax.

Lewis has taught API uses the XML and recognizes messages that conform to industry standard format (Col 9 lines 41-44.)

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to modify the teaching of Pepe such that to have the API being configured to interpret XML syntax, the message and the designation being expressed as a request formatted in XML syntax

A person with ordinary skill in the art would have been motivated to make the modification to Pepe because XML is already known as an industry standard format that would achieves high scalability via multi-processing and parallel processing on Unix, NT, and mainframe computing configurations (Col 6 lines 1-6).

23. Referring to claims 14, 26, claims 14, 26 encompass the same scope of the invention as that of the claim 2. Therefore, claims 14, 26 are rejected for the same reason as the claim 2.

24. Claims 10-11, 22-23, 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe.



25. Referring to claim 10, Pepe has taught an invention as described in claim 1, Pepe has further taught wherein the message is addressed to at least one contact, the API causing the message server to pose the message to the at least one contact (see figure 40-45, and Col 36, lines 10-52. Referring to claim 11, Pepe has further taught wherein the API is further configured to respond to status requests from the application, the API returning, in response to a status request specifying a messaging task, status information pertinent to the messaging task (see Figure 31, and Col 34 lines 37-46.)

However, in claims 10 and 11, Pepe has not explicitly taught the message comprising a question and the response to a status request is a response to the question.

However, a person with ordinary skill the art would know, a message could contain any kind of information that the sender wishing to send to the receiver, which including a question that the sender is attempting to ask the receiver.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to modify the teaching of Pepe such that to make his message as a question and have the respond to the status request is a response to the question.


A person with ordinary skill in the art would have been motivated to make the modification to Pepe because a message could be any kind of information including a question.

26. Referring to claims 22-23, 34-35, claims 22-23, 34-35 encompass the same scope of the invention as that of the claims 10-11. Therefore, claims 22-23, 34-35 are rejected for the same reason as the claims 10-11.

***Conclusion***

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liang-che Alex Wang whose telephone number is (703) 305-3391. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.
28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam Hosain T can be reached on (703)308-6662. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.
29. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Liang-che Alex Wang *LW*  
July 2<sup>nd</sup>, 2003

  
HOSAIN T. ALAM  
PRIMARY EXAMINER